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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,315	03/29/2001	Motoharu Akiyama	OPS Case 527	2264

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EXAMINER

HOWARD, JACQUELINE V

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 07/02/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/821,315

Examiner

Jacqueline V. Howard

Applicant(s)

AKIYAMA, MOTOHARU

Art Unit

1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 3, the phrase "such as" renders the claim indefinite because it is not clear whether the limitations following the phrase are part of the claimed invention. See MPEP 2173.05(d). Also, the recitation "and so forth renders the claim indefinite.

Claim 5 recites the limitation "said sulfonate based anticorrosive" in line 3. There is insufficient antecedent basis for this limitation in the claim.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 to 5 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Matsuzaki et al (5,958,850) or Pillon et al (5,227,082) or JP 60031598.

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Matsuzaki et al prepare a rust preventive composition comprising a base oil and a rust inhibitor. The base oil may be a synthetic olefinic hydrocarbon (col. 2, lines 64-66) having a kinematic viscosity at 40° C of 500 mm<sup>2</sup>/s maximum (col. 3, line 55). ~~The~~ rust inhibitor is present in an amount of 2.0 to 30% by weight. At col. 9, lines 45 to 50, metal sulfonates are taught as such rust inhibitor.

Pillon et al teach lubricating oils having enhanced rust inhibiting and demulsibility performances comprising a synthetic lubricating oil and a rust inhibitor. See col. 3, line 24 for teaching of sulfonic acid containing groups as the rust inhibitor. Note also Table I Base oil F(6) which is a poly alphaolefin synthetic base oil having a kinematics viscosity within the claimed range.

The Japanese reference teaches a composition for lubricating plastic ball seats comprising a synthetic polyalphaolefin and a wax component. The listed wax component is a rust inhibitor.

Applicant claims an anticorrosive lubricant composition for molded plastic products comprising a synthetic hydrocarbon base oil and a corrosion prevention additive. It is the examiner's position that the above references clearly anticipate or at least render the claimed invention prima facie obvious. The '850 and '082 references do not teach using the lubricant composition for molded plastic products. It is the Examiner's position that applicant is claiming a composition not a method of use. Intended use is of no avail in determining patentability of a composition per se. The Japanese reference does teach using the composition to impart corrosion resistance to a plastic product.

Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 60031598 or Boerwinkle et al (4,290,912).


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Both of these references teach a plastic article having corrosion inhibiting properties, wherein said article comprise a polyolefin and a corrosion-inhibiting additive. Applicants claimed plastic product is deemed to be suggested by these references to the extent rendering it prima facie obvious. One of ordinary skill in the art would be motivated to form a corrosion inhibiting plastic or at least coat one with a polyolefin and corrosion preventive additive because the prior art teaches preparing or treating the same type plastic articles for the purpose of enhancing corrosion inhibiting properties. It is not unobvious to follow the teachings of the prior art.

Any inquiry concerning this communication should be directed to J. Howard at telephone number 703 308-2514.

Examiner Howard/ng

July 9, 2002

  
J. HOWARD  
PRIMARY EXAMINER  
GROUP 1700